UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
FOX, BRYAN J

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO 90C (Rev 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _02 August 2004_.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-18_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-18_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
   application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _20040416_.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-4, 6, 15 and 16 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Kraft in view of Smith et al. (US006333973B1).

Regarding claims 1 and 15, Kraft discloses a wireless communication terminal

having sorting means for sorting short messages into an appropriate folder for storage

(see column 2, lines 46-67), which reads on the claimed "method of storing information

from a mobile communications terminal". In this method, a folder, which reads on the

claimed "storage location", is provided with sorting means to select short messages

(see column 4, lines 29-30), when receiving or sending a short message and a user of

the terminal may define certain sorting criteria in the folder (see column 4, lines 34-43),

which reads on the claimed "determining a storage criteria based on predetermined criteria, and storing the information to said storage location". Kraft fails to disclose storage locations available over the network.

Smith et al. discloses a system for storing various information sent to a user where voice mail is stored on a voice mail server (see column 7, lines 40-41), fax is stored on a fax mail server (see column 7, lines 78-58), email is stored on an email server (see column 8, lines 1-2) and a user may download information from the server when it is desired (see column 10, lines 48-56 where the process of downloading an email is described).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Kraft to include the above external storage disclosed by Smith et al. in order to save precious internal memory space as suggested by Smith et al. (see column 2, lines 7-12).

Regarding claim 16, the combination of Kraft and Smith et al discloses that the system is intended for a wireless communication terminal (see Kraft column 2, lines 46-48) and the description mobile phones are used as the wireless communication terminals (see Kraft column 3, lines 51-52).

Regarding claim 2, Kraft discloses a system for storing SMS messages where a user can create folders (see column 6, lines 1-21 and figure 4), which read on the claimed "storage locations", and the user also defines rules for sorting messages to the different folders (see column 4, lines 52-64), which reads on the claimed "determining a preferred storage location selected by the user" and "storing the information at a used

storage location, without informing the user of the used storage location". Kraft also

discloses a menu listing the various folders and for the purpose of defining the

parameters associated with the folders (see column 4, lines 44-60), which reads on the

claimed "presenting to a user a list of available storage locations". Kraft fails to disclose

storage locations available over the network.

Smith et al. discloses a system for storing various information sent to a user

where voice mail is stored on a voice mail server (see column 7, lines 40-41), fax is

stored on a fax mail server (see column 7, lines 78-58), email is stored on an email

server (see column 8, lines 1-2) and a user may download information from the server

when it is desired (see column 10, lines 48-56 where the process of downloading an

email is described).

It would have been obvious to a person of ordinary skill in the art at the time of

the invention to modify Kraft to include the above external storage disclosed by Smith et

al. in order to save precious internal memory space as suggested by Smith et al. (see

column 2, lines 7-12).

Regarding claim 3, Kraft discloses a system for storing SMS messages where a

user can create folders (see column 6, lines 1-21 and figure 4), which read on the

claimed "storage locations", and the user also defines rules for sorting messages to the

different folders (see column 4, lines 52-64), which reads on the claimed "storing an

order of preference of said storage locations, selected by the user" and "determining a

storage location to be used, based on the order of preference of said storage locations".

Kraft also discloses a menu listing the various folders and for the purpose of defining

the parameters associated with the folders (see column 4, lines 44-60), which reads on

the claimed "presenting to a user a list of available storage locations". When a

message is received, it is sorted accordingly (see column 5, lines 30-62 and figure 3),

which reads on the claimed "storing the information at the used storage location, without

informing the user of the identity of the used storage location". Kraft fails to disclose

storage locations available over the network.

Smith et al. discloses a system for storing various information sent to a user

where voice mail is stored on a voice mail server (see column 7, lines 40-41), fax is

stored on a fax mail server (see column 7, lines 78-58), email is stored on an email

server (see column 8, lines 1-2) and a user may download information from the server

when it is desired (see column 10, lines 48-56 where the process of downloading an

email is described).

It would have been obvious to a person of ordinary skill in the art at the time of

the invention to modify Kraft to include the above external storage disclosed by Smith et

al. in order to save precious internal memory space as suggested by Smith et al. (see

column 2, lines 7-12).

Regarding claim 4, Kraft discloses a system for storing SMS messages where a

user can create folders (see column 6, lines 1-21 and figure 4), which read on the

claimed "storage locations", and the user also defines rules for sorting messages to the

different folders (see column 4, lines 52-64),.which reads on the claimed "determining a

preferred storage location selected by the user". Kraft also discloses a menu listing the

various folders and for the purpose of defining the parameters associated with the

folders (see column 4, lines 44-60), which reads on the claimed "presenting to a user a list of available storage locations". When a message is received, it is sorted accordingly (see column 5, lines 30-62 and figure 3), which reads on the claimed "storing the information at a used storage location, without informing the user of the identity of the used storage location". Kraft fails to disclose storage locations available over the network.

Smith et al. discloses a system for storing various information sent to a user where voice mail is stored on a voice mail server (see column 7, lines 40-41), fax is stored on a fax mail server (see column 7, lines 78-58), email is stored on an email server (see column 8, lines 1-2) and a user may download information from the server when it is desired (see column 10, lines 48-56 where the process of downloading an email is described).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Kraft to include the above external storage disclosed by Smith et al. in order to save precious internal memory space as suggested by Smith et al. (see column 2, lines 7-12).

Regarding claim 6, Kraft discloses a system for storing SMS messages where a user can create folders (see column 6, lines 1-21 and figure 4), which read on the claimed "storage locations", and the user also defines rules for sorting messages to the different folders (see column 4, lines 52-64), which reads on the claimed "selecting a storage location". Kraft also discloses a menu listing the various folders and for the purpose of defining the parameters associated with the folders (see column 4, lines 44-

60), which reads on the claimed "list". When a message is received, it is sorted accordingly (see column 5, lines 30-62 and figure 3), which reads on the claimed "storing the information at a used storage location". Kraft fails to disclose storage locations available over the network.

Smith et al. discloses a system for storing various information sent to a user where voice mail is stored on a voice mail server (see column 7, lines 40-41), fax is stored on a fax mail server (see column 7, lines 78-58), email is stored on an email server (see column 8, lines 1-2) and a user may download information from the server when it is desired (see column 10, lines 48-56 where the process of downloading an email is described).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Kraft to include the above external storage disclosed by Smith et al. in order to save precious internal memory space as suggested by Smith et al. (see column 2, lines 7-12).

Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft in view of Smith et al, and further in view of Jeon (US006205331B1).

Regarding claim 5, the combination of Kraft and Smith et al. fails to teach the storing of information in another location based on availability of storage space.

Jeon discloses a paging system where when a page is received, one storage location is checked for space (see step 51, figure 3). If space is available there, the paging data is stored there (see step 55, figure 3), which reads on the claimed "storing the information at a first preferred storage location...if sufficient storage is available

there", however, if space is not available the one storage location, a second location is checked for storage space (see figure 3, step 53) and if space is available there, the paging data is stored there (see figure 3, step 54), which reads on the claimed "storing the information at a second preferred storage location...if insufficient storage is available at the first preferred storage location".

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Kraft and Smith et al. to include the above checking for available storage disclosed by Jeon in order to utilize the available memory optimally and minimize any possibility of erasing important information desired by the user.

Regarding claim 7, Kraft discloses a system for storing SMS messages where a user can create folders (see column 6, lines 1-21 and figure 4), which read on the claimed "storage locations", and the user also defines rules for sorting messages to the different folders (see column 4, lines 52-64), which reads on the claimed "storing the information at a first preferred location". Kraft also discloses a menu listing the various folders and for the purpose of defining the parameters associated with the folders (see column 4, lines 44-60), which reads on the claimed "presenting to a user a list of available storage locations". Kraft fails to disclose storage locations available over the network.

Smith et al. discloses a system for storing various information sent to a user where voice mail is stored on a voice mail server (see column 7, lines 40-41), fax is stored on a fax mail server (see column 7, lines 78-58), email is stored on an email

server (see column 8, lines 1-2) and a user may download information from the server when it is desired (see column 10, lines 48-56 where the process of downloading an email is described).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Kraft to include the above external storage disclosed by Smith et al. in order to save precious internal memory space as suggested by Smith et al. (see column 2, lines 7-12). The combination of Kraft and Smith et al. fails to teach the checking for sufficient storage at a storage location.

Jeon discloses a paging system where when a page is received, one storage location is checked for space (see step 51, figure 3). If space is available there, the paging data is stored there (see step 55, figure 3), which reads on the claimed "storing the information at a first preferred storage location...if sufficient storage is available there", however, if space is not available the one storage location, a second location is checked for storage space (see figure 3, step 53) and if space is available there, the paging data is stored there (see figure 3, step 54), which reads on the claimed "storing the information at a second preferred storage location...if insufficient storage is available at the first preferred storage location".

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Kraft and Smith et al. to include the above checking for available storage disclosed by Jeon in order to utilize the available memory optimally and minimize any possibility of erasing important information desired by the user.

Claims 8, 10, 11, 17 and 18 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Smith et al. in view of Abe et al. (US006249668B1).

Regarding claims 8 and 17, Smith et al. discloses an information system for

mobile phones where a user is presented with a selectable, scrollable list of notification

headers for all the received messages (see column 8, lines 36-40 and figure 7A and

7B), which reads on the claimed "presenting to a user a list of available data items".

These items are stored on servers separate from the mobile telephone 1100 (see

figures 1 and 3), and if a user wants to view a fax, it is retrieved from the fax server (see

column 10, lines 18-29) or if a user wants to view an email it is downloaded from the

email server (see column 10, lines 38-56), which reads on the claimed "at least one

data item stored at a storage location accessible over a mobile communications

network". Smith et al. fails to expressly disclose the use of memory inside the mobile

telephone.

Abe et al. discloses a radio pager with a directory structure for storing messages

(see column 1, lines 59-67). The folders and management of the folders are within the

pager (see column 3, lines 25-45 and figure 1), which reads on the claimed "at least one

data item stored at a storage location in said terminal".

It would have been obvious to a person of ordinary skill in the art at the time of

the invention to modify Smith et al. to include the above internal storage disclosed by

Abe et al. in order to allow a user to access messages without a network connection.

Regarding claim 10, the combination of Smith et al. and Abe et al. discloses the

use of identification icons 7500 for identifying the type of message (see Smith et al.

column 8, lines 40-45 and figures 7A and 7B). Since different types of messages are

stored in different locations, such as email messages on the email server and fax

messages on the fax server (see Smith et al. figure 5), the icons identifying the type of

message are also indicative of the location of the message, which reads on the claimed

"presenting the list of available items, together with an indication of their respective

storage locations".

Regarding claim 11, in the combination of Smith et al. and Abe et al, the user

does not need to specify where the data is stored, instead, he is presented a list of all

the available items to choose from (see Smith et al. column 8, lines 36-45 and figure 7A

and 7B).

Regarding claim 18, the combination of Smith et al. and Abe et al. discloses the

use of a mobile phone in the invention (see Smith et al. column 3, lines 60-67 and figure

1 and 2).

Claims 9, 12, 13 and 14 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Smith et al. in view of Abe et al, and further in view of Wicks et al.

(US005796394A).

Regarding claim 9, the combination of Smith et al. and Abe et al. fails to

expressly disclose a system where a user is not informed of the location of information.

Wicks et al. discloses a user interface for a personal communications system

with an interface that shows icons corresponding to different types of information (see

column 7, lines 35-53 and figure 4). However, Wicks et al. also discloses that some

devices may not have sufficient resolution for such displays so the user interface is

simple enough so that a user may operate the interface without visual feedback or with a limited display interface (see column 9, lines 26-31). If the above system does not have the icons, the user would not know the corresponding locations of the information as claimed.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Smith et al. and Abe et al. to include the above lower resolution interface disclosed by Wicks et al. in order to provide compatibility with devices not equipped with such high resolution displays as suggested by Wicks et al. (see column 9, lines 19-25).

Regarding claim 12, the combination of Smith et al. and Abe et al. fails to expressly disclose that multiple users may access the servers.

Wicks et al. discloses a user interface for a personal communications where messages are retrieved from a base station 108 (see column 3, lines 52-60 and figure 1) and multiple users access the base station (see column 7, lines 21-34 and figure 4), which reads on the claimed "items stored centrally on the remote storage device being accessible by multiple users".

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Smith et al. and Abe et al. to include the above system allowing access by multiple users disclosed by Wicks et al. in order to allow reuse of equipment and provide a cheaper system.

Regarding claim 13, Smith et al. discloses an information system for mobile phones where a user is presented with a selectable, scrollable list of notification

headers for all the received messages (see column 8, lines 36-40 and figure 7A and

7B), which reads on the claimed "presenting to a user a list of available data items".

These items are stored on servers separate from the mobile telephone 1100 (see

figures 1 and 3), and if a user wants to view a fax, it is retrieved from the fax server (see

column 10, lines 18-29) or if a user wants to view an email it is downloaded from the

email server (see column 10, lines 38-56).

Abe et al. discloses a radio pager with a directory structure for storing messages

(see column 1, lines 59-67). The folders and management of the folders are within the

pager (see column 3, lines 25-45 and figure 1), which reads on the claimed "at least one

data item stored by the user".

It would have been obvious to a person of ordinary skill in the art at the time of

the invention to modify Smith et al. to include the above internal storage disclosed by

Abe et al. in order to allow a user to access messages without a network connection.

The combination of Smith et al. and Abe et al. fails to expressly disclose that multiple

users may access the servers.

Wicks et al. discloses a user interface for a personal communications where

messages are retrieved from a base station 108 (see column 3, lines 52-60 and figure

1) and multiple users access the base station (see column 7, lines 21-34 and figure 4),

which reads on the claimed "at least one item stored by a central source and accessible

by multiple users".

It would have been obvious to a person of ordinary skill in the art at the time of

the invention to modify the combination of Smith et al. and Abe et al. to include the

above system allowing access by multiple users disclosed by Wicks et al. in order to allow reuse of equipment and provide a cheaper system.

Regarding claim 14, the above combination of Smith et al, Abe et al. and Wicks et al. fails to expressly disclose a system where a user is not informed of the location of information.

Wicks et al. discloses a user interface for a personal communications system with an interface that shows icons corresponding to different types of information (see column 7, lines 35-53 and figure 4). However, Wicks et al. also discloses that some devices may not have sufficient resolution for such displays so the user interface is simple enough so that a user may operate the interface without visual feedback or with a limited display interface (see column 9, lines 26-31). If the above system does not have the icons, the user would not know the corresponding locations of the information as claimed.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Smith et al. and Abe et al. to include the above lower resolution interface disclosed by Wicks et al. in order to provide compatibility with devices not equipped with such high resolution displays as suggested by Wicks et al. (see column 9, lines 19-25).

Response to Arguments

Applicant's arguments with respect to claims 1, 15 and 16 have been considered but are moot in view of the new ground(s) of rejection.

The applicant argues in the second paragraph of page 15, then again in the first paragraph of page 16, that the combination of Kraft and Smith et al fails to teach or suggest a method of storing information from a mobile communication terminal including storing information in the terminal and in a storage location that is accessible over a network. The examiner respectfully disagrees. As discussed in the rejections of claims 2-4 and 6, Kraft discloses a system for storing SMS messages where a user can create folders (see column 6, lines 1-21 and figure 4), which reads on the claimed "storing information from a mobile terminal." Kraft fails to disclose storage locations available over the network. However, this is what Smith et al discloses (see rejection of claim 2 above).

The applicant argues in the second paragraph of page 18 that the combination of Kraft, Smith et al and Jeon fails to disclose a method in which information from a mobile communication terminal can be stored either in a terminal or a storage location that is accessible over a network while storing the information at a preferred location selected by the user. The examiner respectfully disagrees. As discussed above in the rejection of claim 7, Kraft discloses a system for storing SMS messages where a user can create folders (see column 6, lines 1-21 and figure 4), and the user also defines rules for sorting messages to the different folders (see column 4, lines 52-64). Kraft fails to disclose storage locations available over the network, however Smith discloses this (see rejection of claim 7 above).

The applicant argues in the second paragraph of page 20 that the combination of Smith et al and Abe et al would not be possible since Smith et al only discloses storing

information externally while Abe et al only discloses storing information internally. The examiner respectfully disagrees and asserts that the combination teaches storing information both internally and externally as claimed.

The applicant argues in the first paragraph of page 23 that the combination of Smith et al, Abe et al and Wicks et al fails to disclose presenting a user with a list of available data including a data item stored by a user and a data item accessible by multiple users. The examiner respectfully disagrees. As discussed in the rejection of claim 12 above, Wicks et al. discloses a user interface for a personal communications where messages are retrieved from a base station 108 (see column 3, lines 52-60 and figure 1) and multiple users access the base station (see column 7, lines 21-34 and figure 4), which reads on the claimed "items stored centrally on the remote storage device being accessible by multiple users".

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan J Fox whose telephone number is (703) 305-8994. The examiner can normally be reached on Monday through Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

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Business Center (EBC) at 866-217-9197 (toll-free).

Marsha D. Banks-Harold

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